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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,424	05/18/1999	BERTRAM V. BURKE	EPC-71	5182

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04/18/2002

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 04/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/314,424

Applicant(s)

BURKE, BERTRAM V.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response To Applicant's amendment

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn **and a new Final Office Action is now submitted as shown below.**

The new title "Method and System For Providing Rebates From Merchants to Organizations" was considered, but not approved. Here is a preferred or suggested title --
Method and System For Providing Rebates From Merchants to Non-Profit Organizations-

The new abstract described by the Applicant on page 4 of the amendment after final could not be found.

Response to Arguments

First of all, Applicant argues that **it is the merchant's money that is given to the non-profit organization in the form of a rebate by the merchant, not the customer's or donor's money as mentioned in the Burke's reference.** However, none of the pending claims recites the latter feature. In response to this argument that the Burke's reference fail to show the latter feature of applicant's invention, it is noted that the latter feature upon which applicant relies upon is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Second of all, Applicant further argues **that a central clearinghouse reports all transaction data to the merchants who in turns forward the donations or rebates to the non-profit organizations**, as recited in claim 1. Here is the Examiner's response-

Burke does not expressly disclose the involvement of a clearinghouse in reporting all transactions to a merchant who subsequently forwards a rebate to a non-profit organization.

However, it is understood that the use of a clearinghouse in processing coupon, rebate and voucher redemption data, in a manner well known to those skilled in the art, so that payments can be made to respective parties involved in a particular marketing scheme, such as Cross-selling products, is very popular in the industry. For example, a manufacturer, during a promotional campaign for a brand new product, may use the service of a clearinghouse not only to distribute coupons associated with the promoted product and redeemable at specific stores, but also to collect redemption data from various stores used to calculate the amount of money that must be reimbursed to the store owners and to measure the effectiveness of the campaign. Using the redemption data, the clearinghouse will prepare monthly or quarterly billing statements for various store owners and subsequently forward the billing statements to the manufacturer so that appropriate payments can be made to different store owners for accepting the manufacturer's coupons.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a third party such as a clearinghouse along with Burke's system so as to allow

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the clearinghouse, upon filtering the data, to report all transaction information and more specifically donated amounts or donors' contributions back to the merchants or merchants' remote terminal RT1 of fig.1 from the Central Computer or CC of fig.1 (or clearinghouse computer) via the communication system (CS) so that the merchants can forward the accumulated donations or rebates to appropriate non-profit organizations, thereby eliminating the need for a charity to have a computer or a system CHY remotely linked to Central Computer or CC of fig. 1 to electronically receive the donations while ensuring that the rebates or total accumulated contributions or donations collected from donors on behalf of specific charities are fully transferred by the participating merchants or retailers to the specific charities. Finally, eliminating the need for charities to have a computer or system remotely connected to the Central Computer or CC via communication system CS makes it convenient for small charitable organizations that cannot afford to hire computer system administrators to administer their computer network remotely connected to the Central Computer or CC of fig. 1 to receive their donations in the form of a rebate check or voucher directly from the participating merchants or retailers.

Therefore, the present office action rejection regarding claims 1-7, as submitted below, **has been made final** since the Applicant's arguments as herein described are not plausible.

\ DETAILED ACTION

Specification

Status of the claims

Claim 1 was originally presented. After the First Non-final Office Action, claim 1 was superficially amended and claims 2-7 were added. Claims 1-7 are now pending in the Instant Application.

Claim Objections

Claim 7 is objected to because of the following informalities:

As per claim 7, “maintaining a schedule of rebates due from **the** each of the ..” should apparently be -- maintaining a schedule of rebates due from each of the...--. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke, U.S Patent 5,621,640, published on April 15, 1997.

As per claim 1, Burke teaches a method comprising the steps of:

1.

Providing each of a plurality of supporters **or donors** with an individual identification number (ID) **DC1 of fig. 2 or DC2 of fig. 3**. See column 3 and third paragraph;

Entering the (ID) **DC1 or DC2** into an entry terminal **such as Card Reader CDX or Bar Code Reader BCRX of fig. 1**;

Entering an amount spent by a supporter **or donor** at a merchant in a transaction using **Cash Register CRX POS as depicted in fig. 1**. See columns 2-3 and lines 51-72;

Having the entry terminal **Card Reader CDX or Bar Code Reader BCRX of fig. 1** record the (ID) **DC1 or DC2** as well as the amount of dollars spent in a transaction **into the Cash Register CR1 of fig. 1, which in turn sends the data to CC (central computer) to be stored in DS (data storage) of fig. 1**; See columns 2-3 and lines 51-85;

Uploading the ID **from a donor's card DC1 of fig. 1** and the amount entered to a central clearinghouse **or Central Computer or CC of fig. 1 via communication system CS, which transfers the amount to a selected charity account CA or a charity computer CHY of fig. 1**

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(col. 3: 10-27-The Examiner notes that there is no difference between the functions performed by the Central Computer or CC of fig. 1 and the central clearinghouse. At this point, it will be evident to one having ordinary skill in the art that the central clearinghouse must use a central computer remotely connected to various participating merchants POS in a manner similar to CC as shown in fig. 1. Therefore, the Examiner will treat the Central Computer or CC of fig. 1 as a clearinghouse system or fulfillment system or an automatic clearinghouse or ACH).

Burke does not expressly disclose the involvement of a clearinghouse in reporting all transactions to a merchant who subsequently forwards a rebate to a non-profit organization.

However, it is understood that the use of a clearinghouse in processing coupon, rebate and voucher redemption data, in a manner well known to those skilled in the art, so that payments can be made to respective parties involved in a particular marketing scheme, such as Cross-selling products, is very popular in the industry. For example, a manufacturer, during a promotional campaign for a brand new product, may use the service of a clearinghouse not only to distribute coupons associated with the promoted product and redeemable at specific stores, but also to collect redemption data from various stores used to calculate the amount of money that must be reimbursed to the store owners and to measure the effectiveness of the campaign. Using the redemption data, the clearinghouse will prepare monthly or quarterly billing statements for various store owners and subsequently forward the billing statements to the manufacturer so that appropriate payments can be made to different store owners for accepting the manufacturer's coupons.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a third party such as a clearinghouse along with Burke's system so as to allow the clearinghouse, upon filtering the data, to report all transaction information and more specifically donated amounts or donors' contributions back to the merchants or merchants' remote terminal RT1 of fig.1 from the Central Computer or CC of fig.1 (or clearinghouse computer) via the communication system (CS) so that the merchants can forward the accumulated donations or rebates to appropriate non-profit organizations, thereby eliminating the need for a charity to have a computer or a system CHY remotely linked to Central Computer or CC of fig. 1 to electronically receive the donations while ensuring that the rebates or total accumulated contributions or donations collected from donors on behalf of specific charities are fully transferred by the participating merchants or retailers to the specific charities. Finally, eliminating the need for charities to have a computer or system remotely connected to the Central Computer or CC via communication system CS makes it convenient for small charitable organizations that cannot afford to hire computer system administrators to administer their computer network remotely connected to the Central Computer or CC of fig. 1 to receive their donations in the form of a rebate check or voucher directly from the participating merchants or retailers.

As per claim 2, Burke further discloses a method for collecting donors' or supporters' contributions during POS transactions associated with a plurality of participating merchants or retailers and subsequently distributing the contributions or rebates to non-profit or charitable

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organizations selected by the donors wherein the donors and the non-profit organizations or donees can easily be identified using donor card DC1 Of fig. 2 and charitable account CA of fig. 1 respectively. It should further be understood that the participating or affiliated merchants could easily be identified using specific accounts (bank accounts) or IDs (Abstract; figs. 1-3; col. 1: 18-54; col. 2: 51 to col. 3: 27; col. 4: 41-67; col. 7: 7-26).

As per claims 3 and 6, Burke further discloses a method comprising the following steps-

3. Wherein the steps of recording assigned identification are performed at a remote terminal **RT1 of a participating** merchant wherein RT1 reports donations by donors to specific charities including identifications during transactions throughout various participating merchants POS to CC or Central Computer in real-time via CS (communication system such as cable, satellite etc.) (fig. 1); and

Having the steps of associating, calculating and transmitting are performed by a **Central Computer or CC of fig. 1** (The Examiner notes that there is no difference between the functions performed by the Central Computer or CC of fig. 1 and the central clearinghouse. At this point, it will be evident to one having ordinary skill in the art that the central clearinghouse must use a central computer remotely connected to various participating merchants POS in a manner similar to CC as shown in fig. 1. Therefore, the Examiner will treat the Central Computer or CC of fig. 1 as a clearinghouse system or fulfillment system or an automatic clearinghouse or ACH).

See figs 1-3 and col. 2: 7 to col. 47.

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6. Wherein each step of recording includes uploading each transaction to a **CR1 or cash register 1 associated with remote terminal 1 or RT1 and subsequently transferring the transaction data including donation amounts and identifications to Central Computer or CC of fig. 1** or said clearinghouse or fulfillment center having a central computer or CC and wherein the merchants can receive reports regarding the total accumulated donations or the like (See figs 1-3 and col. 2: 7 to col. 47).

Concerning claims 2-3 and 6, Burke does not expressly disclose the involvement of a clearinghouse in reporting or transmitting all transaction data including all calculated accumulated donations or contributions or rebates back to participating merchants and non-profit organizations wherein the participating merchants eventually forward the total accumulated donations or rebates to the appropriate non-profit organizations.

However, it is understood that the use of a clearinghouse in processing coupon, rebate and voucher redemption data, in a manner well known to those skilled in the art, so that payments can be made to respective parties involved in a particular marketing scheme, such as Cross-selling products, is very popular in the industry. For example, a manufacturer, during a promotional campaign for a brand new product, may use the service of a clearinghouse not only to distribute coupons associated with the promoted product and redeemable at specific stores, but also to collect redemption data from various stores used to calculate the amount of money that must be reimbursed to the store owners and to measure the effectiveness of the campaign. Using the redemption data, the clearinghouse will prepare monthly or quarterly billing statements for

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various store owners and subsequently forward the billing statements to the manufacturer so that appropriate payments can be made to different store owners for accepting the manufacturer's coupons.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a third party such as a clearinghouse along with Burke's system so as to allow the clearinghouse, upon filtering the transaction data, to report all transaction information and more specifically donated amounts or donors' contributions or rebates back to the merchants or merchants' remote terminal RT1 of fig.1 from the Central Computer or CC of fig.1 (or clearinghouse computer) via the communication system (CS) and to the non-profit organizations so that the merchants can forward the accumulated donations or rebates to appropriate non-profit organizations, thereby eliminating the need for a charity or non-profit organization to have a computer or a system CHY remotely linked to Central Computer or CC of fig. 1 to electronically receive the donations while ensuring that the rebates or total accumulated contributions or donations collected from donors on behalf of specific charities are fully transferred or transmitted by the participating merchants or retailers to the specific charities, which can very easily verify whether or not the amount of accumulated rebates sent by the merchants is the same as the amount contained in the received transaction report from the clearinghouse. Finally, eliminating the need for charities to have a computer or system remotely connected to the Central Computer or CC via communication system CS makes it convenient for small charitable organizations that cannot afford to hire computer system administrators to administer their computer network remotely connected to the Central Computer or CC of fig. 1 to receive their

donations in the form of a rebate check or voucher directly from the participating merchants or retailers.

As per claim 7, Burke further discloses a method for collecting donors' or supporters' contributions during POS transactions associated with a plurality of participating merchants or retailers and subsequently distributing the contributions or rebates to non-profit or charitable organizations selected by the donors wherein the donors and the non-profit organizations or donees can easily be identified using donor card DC1 Of fig. 2 and charitable account CA of fig. 1 respectively. It should further be understood that the participating or affiliated merchants could easily be identified using specific accounts (bank accounts) or IDs (Abstract; figs. 1-3; col. 1: 18-54; col. 2: 51 to col. 3: 27; col. 4: 41-67; col. 7: 7-26).

Burke does not expressly disclose the involvement of a clearinghouse in reporting or transmitting all transaction data including all calculated accumulated donations or contributions or rebates back to participating merchants and non-profit organizations wherein the participating merchants eventually forward the total accumulated donations or rebates to the appropriate non-profit organizations based upon a certain scheduling process.

However, it is understood that the use of a clearinghouse in processing coupon, rebate and voucher redemption data, in a manner well known to those skilled in the art, so that payments can be made to respective parties involved in a particular marketing scheme, such as

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Cross-selling products, is very popular in the industry. For example, a manufacturer, during a promotional campaign for a brand new product, may use the service of a clearinghouse not only to distribute coupons associated with the promoted product and redeemable at specific stores, but also to collect redemption data from various stores used to calculate the amount of money that must be reimbursed to the store owners and to measure the effectiveness of the campaign. Using the redemption data, the clearinghouse will prepare monthly or quarterly billing statements for various store owners and subsequently forward the billing statements to the manufacturer so that appropriate payments can be made to different store owners for accepting the manufacturer's coupons.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a third party such as a clearinghouse along with Burke's system so as to allow the clearinghouse, upon filtering the transaction data, to report all transaction information and more specifically donated amounts or donors' contributions or rebates back to the merchants or merchants' remote terminal RT1 of fig.1 from the Central Computer or CC of fig.1 (or clearinghouse computer) via the communication system (CS) and to the non-profit organizations so that the merchants can forward the accumulated donations or rebates to appropriate non-profit organizations based upon a certain schedule (monthly, quarterly, etc.), thereby eliminating the need for a charity or non-profit organization to have a computer or a system CHY remotely linked to Central Computer or CC of fig. 1 to electronically receive the donations on a daily basis or immediately after a transaction while ensuring that the rebates or total accumulated contributions or donations collected from donors on behalf of specific charities are fully

transferred or transmitted from the participating merchants or retailers to the specific charities, which can very easily verify whether or not the amount of accumulated rebates sent by the merchants is the same as the amount contained in the received transaction report from the clearinghouse. Finally, eliminating the need for charities to have a computer or system remotely connected to the Central Computer or CC via communication system CS makes it convenient for small charitable organizations that cannot afford to hire computer system administrators to administer their computer network remotely connected to the Central Computer or CC of fig. 1 to receive their donations in the form of a rebate check or voucher directly from the participating merchants or retailers.

As per claims 4-5, Burke further discloses a method for collecting donors' or supporters' contributions during POS transactions associated with a plurality of participating merchants or retailers and subsequently distributing the contributions or rebates to non-profit or charitable organizations selected by the donors wherein the donors and the non-profit organizations or donees can easily be identified using donor card DC1 Of fig. 2 and charitable account CA of fig. 1 respectively. It should further be understood that the participating or affiliated merchants could easily be identified using specific accounts (bank accounts) or IDs (Abstract; figs. 1-3; col. 1: 18-54; col. 2: 51 to col. 3: 27; col. 4: 41-67; col. 7: 7-26).

Conclusion

Although the following references were not used in the Office Action, they were highly considered by the Examiner. Applicant is further directed to consult these references.

US Patent 5,909,794 to Molbak et al is highly considered under a 102 rejection (abstract; col. 2: 30-55).

US Patent 5,905,246A to Fajkowski discloses a clearinghouse for coupon management and redemption.

US Patent 5,466,919A to Hovakimian discloses a credit/charge card system for enabling purchasers to donate to non-profit organizations or charities.

US Patent 6,052,674A to Zervides et al discloses an electronic invoicing and collection system and method with charity donations.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at
(703) 305-3900.

. Further, the following fax numbers can be used, if need be, by the Applicant(s):


After Final- 703-746-7238

Official Draft-703-746-7239

Non-Official Draft- 703-746-7240

Please provide support, that is page and line numbers, for any amended or new claim, otherwise any new claim language that is introduced in an amended or new claim will be considered as new matter.

11/7/01


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